

REMARKS

Status of the Claims

Claims 1-16 are pending, of which Claims 14-16 are withdrawn.

In the present Amendment, independent Claim 1 has been amended to recite that the solution containing a conducting polymer, water, and/or a hydrophilic solvent is applied on the whole area of the layer (B) to form layer (C) comprising the conducting polymer. In addition, Claim 7 has been amended to recite the layer (C) comprising the conducting polymer on the whole area of the layer (B). Support for the amendments to claims 1 and 7 can be found, for example, at page 11, paragraph [0020] of the present specification. According to paragraph [0020] of the specification:

Although the conducting polymer works well by existing on the certain region of the layer (B) irradiated with a radiation, the conducting polymer may exist on a whole area of the layer (B) composed of the organic polysilane. It is preferable that the conducting polymer exists on the whole area in terms of productivity and flatness of a substrate surface.

No new matter has been added, and entry of this Amendment is respectfully requested.

The Claimed Pattern Substrate is Patentable over Kobayashi and Kajiura

Claims 1-10 and 12-13 were rejected under 35 U.S.C. § 103(a) as being obvious over Kobayashi (JP 2004/071473) in view of Kajiura (U.S. Patent No. 5,907,382).

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi (JP 2004/071473) in view of Kajiura (U.S. Patent No. 5,907,382) as applied to Claim 1, and further in view of Veres (WO 2004/013922).

Applicant traverses and respectfully requests the Examiner to reconsider and withdraw the rejections in view of the arguments in the Appeal Brief filed July 15, 2011, the amendments to the claims and the following remarks.

Kobayashi forms a patterned region having a high wettability on a wettability variable substrate and forms a layer of solute A (which corresponds to the layer (C) in the present claims) on the patterned region (*see, e.g.*, claim 1 of Kobayashi). As a result, the layer of solute A itself becomes a patterned substrate.

In contrast, the amended claims of the present application provide for a layer (C) on the whole area of the radiation-irradiated region of the layer (B) containing an organic polysilane. Accordingly, the structure of the claimed patterned substrate is clearly different from Kobayashi. Further, since Kobayashi requires forming a patterned region and thereafter forming a layer of solute A on the patterned region, Kobayashi does not suggest the claimed structure.

In light of the explanation above, the claimed patterned substrate is patentable over Kobayashi. In addition, the following comments are provided regarding the Examiner's Answer.

At pages 8-9 of the Answer, the Examiner asserts that the entirety of Applicant's arguments in the Appeal Brief were in relation to the process limitations for making the claimed product of a patterned substrate having a conductor pattern. The Examiner indicates that the process limitations themselves are not essential to a determination of patentability of the product-by-process claim. *See* the paragraph bridging pages 8-9 of the Answer.

Applicant disagrees. The Appeal Brief addressed structural differences between the claimed product and the claimed product (*see, e.g.*, the illustration on page 13 of the Appeal Brief). Further, process limitations in a product-by-process claim cannot simply be ignored when they impart a structural/compositional difference to the claimed product. *See, e.g., Amgen Inc. v. F. Hoffmann-La Roche Ltd.*, 580 F.3d 1340 (Fed. Cir. 2009) (holding that an accused product may meet each limitation in a claim, but not possess features imparted by a process limitation that might distinguish the claimed invention from the prior art); *In re Garnero*, 412

AMENDMENT UNDER 37 C.F.R. § 1.114(e)
Application No. 10/594,840 (Attorney Docket No. Q97512)

F.2d 276, 279 (CCPA 1979) (holding “interbonded by interfusion” to limit structure of the claimed composite).

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections based on Kobayashi, Kajiura and Veres.

Conclusion

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local, Washington, D.C. telephone number listed below.

The U.S. Patent and Trademark Office is hereby directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/ Michael G. Raucci /

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Michael G. Raucci
Registration No. 61,444

Date: December 28, 2011